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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,938	12/22/1999	DALE F. MCINTYRE	80369F-P	6786

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PATENT LEGAL STAFF  
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ROCHESTER, NY 14650-2201

EXAMINER
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GRANT II, JEROME

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 09/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/470,938

Applicant(s)

MCINTYRE ET AL.

Examiner

Jerome Grant II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-23 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Jerome Grant II  
PRIMARY EXAMINER

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**Detailed Action**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3-12 and 14-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe.

With respect to claim 1, Watanabe teaches a kit (substantially shown by figure 1) for organizing a plurality of images, comprising: an image retaining device (scanner 7 for generating thumb-nail images, see paragraph 14) for capturing images, the retaining device has a unique ID (see paragraph 45) which has been forwarded to a database (18) of a network(5); a registration card (conventional paper album/photo album with ID) for using to access the provider for registering

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said image retaining device to a customer (see paragraphs 67 and 70) and a computer software program such that when loaded on a computer will allow the consumer to accomplish certain operations at the network provider, see computer 6 and paragraph 44.

With respect to claims 3 and 15, Watanabe teaches information from Internet 5 which represents the photo image goods and services.

With respect to claim 4, see paragraph 41.

With respect to claims 5 and 18, see paragraph 51 and 67.

With respect to claims 6 and 19, see paragraph 46 where the image processing is the changing of the image content.

With respect to claims 7 and 20, Watanabe teaches wherein the plurality of image retaining devices (thumbnail) images are provided in a single package (photo image album).

With respect to claims 8, 17 and 21 see the film 13 inside of the retaining device (camera).

With respect to claims 9 and 22, see the film 13 with ID information on the film cartridge.

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With respect to claim 10, Watanabe teaches the film is part of a cartridge 13 of a single package (see paragraph 39).

With respect to claim 11, Watanabe teaches a plurality of stickers (header information with ID's attached) see figure 64.

With respect to claim 12, the header information is the means for sticking ID with image content which has been read by scanner 7.

With respect to claim 14, Watanabe teaches a registration card (conventional paper album/photo album with ID) for using to access the provider for registering said image retaining device to a customer (see paragraphs 67 and 70) and a computer software program such that when loaded on a computer will allow the consumer to accomplish certain operations at the network provider, see computer 6 and paragraph 44.

With respect to claim 16, this limitations is addressed by paragraph 44.

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With respect to claim 23, Watanabe teaches the kit, as shown by figure 5, for organizing plural images comprising: an image storage device (database 18) for storing of images, said image storage device having a unique ID (according to paragraph 45) which has been forwarded to a database of a network photo service provider wherein said unique ID is used by said network provider (any of stations 3 or 4); and a computer software program for performing the operations, see computer 6 at paragraph 44.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of the Well Known Prior Art. (Official Notice).

While Watanabe teaches all of the subject matter upon which the claim depends, including the use of a computer for providing the program to facilitate the kit, it is not clear if the program is stored in a specific memory source called a CD. It appears that the program is stored in a ROM of the Computer 6.

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The examiner submits that CDS and CD ROM are interchangeable mediums for storing software programs for use on computer applications. Therefore, the use of a CD or other portable storage medium, as opposed to a ROM, would have been obvious to one of ordinary skill in the art of software storage. It would have been obvious to replace the storage medium for storing the software program with a CD type storage means for the purpose of storing a software program.

3. Claims Objected

Claim <sup>13</sup>~~13~~<sub>1</sub> is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 703-305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.



J. Grant II

JEROME GRANT II  
PRIMARY EXAMINER